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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,124	01/28/2002	Jeffrey S. Pickering	DAO101	5907

20482 7590 10/09/2003

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EXAMINER

RADA, ALEX P

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/060,124

Applicant(s)

PICKERING ET AL.

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. Claims 3, 4, and 9 are objected to because of the following informalities: the programmed is misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2 is vague and indefinite on how the surface of the playing area, as claimed in claim 1, is incorporated as part of the data within the computer.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 3 and 6-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The non-statutory subject matter of claims 6-9 is directed to providing living subject matters (human beings) for a game.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Play Dao website.

8. The Play Dao website discloses a board game having the following:

a. a surface with a playing area having sixteen playing positions arranged in a four-by-four grid;

b. eight playing pieces in two sets of four, each of the sets distinguishable from the other;
and

c. rules of the game (about Dao page) as recited in claim 1;
the playing area, rules of the game, and the playing positions all exist as data within a computer, and having at least a portion of the data is displayed on an output means as recited in claims 2 and 7;

the computer is programmed to play against a human opponent (the Play online DAO page) as recited in claims 3 and 8;

the computer is programmed to allow two players to compete against each other while the computer keeps track of the locations of the playing pieces (the Play online DAO page) as recited claims 4 and 9;

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the game having additionally printed matter setting forth a method of play therefor, and the method of play is the rules of the game (about Dao page) as recited in claim 5;

the game board method having the following:

- a. providing a playing surface with a playing area having sixteen playing positions arranged in a four-by-four grid;
- b. providing eight playing pieces in two sets of four, each of the sets distinguishable from the other;
- c. providing two players, one of whom may be a computer;
- d. assigning each of the two players one of the sets of the playing pieces;
- e. placing the playing pieces on the playing surface in the starting configuration, wherein the starting configuration is an "X" with each of the player's pieces forming one leg of the "X" aligned diagonally from the corners of the playing surface;
- f. selecting a first player, who begins play by moving one of the playing pieces assigned to that player from the starting configuration to any one of the playing positions, subject to the provision that in completing a move, the move must in a straight line, and the one of the playing pieces must be moved as far as possible until the one of the playing pieces reaches the end of the playing area or another of the playing pieces, and further subject to the provision that in completing the move, the one of the playing pieces cannot be moved over another of the playing pieces or to one of the playing positions that is already occupied by another of the playing pieces;
- g. selecting a second player who continues play by making a move subject to the same conditions of the move of the first player;

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h. continuing play during which the first player and the second player, in alternating turns, make moves until one player is declared the winner; and i. declaring the winner to be the player who aligns his or her playing pieces to:

- i. form any straight line except a diagonal line;
- ii. occupy all of the playing positions in the corners of the playing surface at the same time;
- iii. form a square configuration with all of the winner's playing pieces adjacent to each other; or
- iv. have any one of the winner's playing piece blocked in any one of the playing positions at the corners of the playing surface by three of the playing pieces of the other player as recited in claim 6.

9. Claim 1 are rejected under 35 U.S.C. 102(b) as being anticipated by Kerry Handscomb, review from Abstract Games Magazine (copyright from play Dao website 1999).

10. The review from Abstract Games Magazine discloses a board game having the following:

- a. a surface with a playing area having sixteen playing positions arranged in a four-by-four grid;
 - b. eight playing pieces in two sets of four, each of the sets distinguishable from the other;
- and
- c. rules of the game.

11. Claim 1 are rejected under 35 U.S.C. 102(b) as being anticipated by Lamie '080.

12. Lamie discloses board game having a surface with a playing area having sixteen playing positions arranged in a four-by-four grid, eight playing pieces in two sets of four, in which the

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examiner interprets the Lamie reference to have the equivalent to the claimed eight playing pieces in two sets of four, each of the sets distinguishable from the other (squares and circles) and rules of the game.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

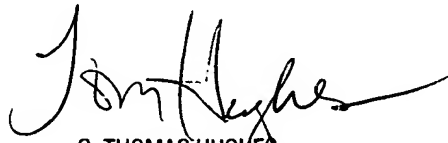
Lachenmeier '951, Kindred '535, Daitzman '120, and Denoual '455 all discloses different types of board games having four by four grid playing surface.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

for
apr


S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700